



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,001	03/21/2000	Thomas John Goodwin	MSC-22859-2-CU	7201
24957	7590	07/02/2004	EXAMINER	
NASA JOHNSON SPACE CENTER MAIL CODE HA 2101 NASA RD 1 HOUSTON, TX 77058			LACOURCIERE, KAREN A	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

3-M.

Advisory Action

Application No.

09/532,001

Applicant(s)

GOODWIN ET AL.

Examiner

Karen A. Lacourciere

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3, 5-10, 27, 28, 31-35 and 37.


Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicant's amendments have changed to scope of the claims from nucleic acids encoding shear stress response elements and methods that use nucleic acids encoding shear stress response elements to nucleic acids comprising shear stress response elements and methods using nucleic acids comprising shear stress response elements. This change would require a new search and new considerations. Applicant's amendments to claim 1 would require a rejection to claim 8, which no longer further limit claim 1.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, Applicant's amendments to claims 2, 33 and 35 would overcome the objection to those claims. If entered, Applicant's amendments would overcome the rejection of record of claims 1-3, 5-10, 27, 28 and 31 under 35 USC 112, second paragraph. If entered, Applicant's amendments would overcome the rejection of record of claims 1-3, 5-10, 27, 28, 31-35 and 37 under 35 USC first paragraph for new matter.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that claim 10 does not include new matter because the skilled artisan would understand that mm meant millimolar. This has not been found to be persuasive because the art recognized abbreviation for millimolar is not mm, but rather mM. The skilled artisan would recognize mm as millimeter. Applicant argues that there is adequate written description for the SSRE's as amended to nucleic acids "comprising" because Examples 11 and 15 demonstrate the induction and inhibition of differentially expressed genes in the presence of SSRE's and identifies 7 species of genes induced by one SSRE and discusses art references that discuss genes regulated by SSRE's, therefore, there is ample description to identify genes regulated by SSRE's. This is not persuasive because Applicant is arguing the amended claims, and these amendments have not been entered. Further, the basis for the rejection is not that genes regulated by SSRE's have not been identified, but rather the structure of the genus of SSRE's have not been described. Although Applicant provides a subsequence of the claimed SSRE's, the filed related to this subject matter indicates that the flanking regions of this sequence are essential to the function and, therefore, the subsequence alone would not be adequate to describe the genus of SSRE's claimed. Therefore, the genus of SSRE's have not been described..


KAREN A. LACOURCIERE, Ph.D.
PRIMARY EXAMINER